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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Mitchell R. Swartz, ScD, MD, EE
16 Pembroke Rd.
Weston, MA 02481

May 1, 2002

In Re: Mitchell R. Swartz
Serial No. 09/750,480
Filed: December 28, 2000

: Decision on Petition under
: 37 C.F.R. 1.181

For: Method and Apparatus to Monitor Loading Using Vibration.

This is a decision on the petition filed March 1, 2002 under 1.181 to "correct a situation with respect to the recent unsigned unnumbered Office Notice".

The applicant petitions for review of the requirement for election of species and to recluse the examiner from the application.

The prosecution history of the file is as follows:

On May 07, 2001, a requirement to elect a single species of the claimed invention was mailed. The election requirement consisted of 4 embodiments and upon election of one of the four embodiments, applicant was required to further elect 3 additional subspecies of the elected embodiment. The requirement required an election of all the species and identification of claims, irrespective of an argument with respect to the requirement.

On June 4, 2001 applicant responded to the election requirement. In the response applicant traversed the requirement, failed to elect one of the 4 embodiments and improperly elected one of the 3 subspecies. Additionally, applicant did not identify any claims readable on the elected species.

On January 16, 2002, a notice of non-compliant amendment was mailed to the applicant. The notice stated that applicant has failed to elect one of the 4 embodiments, improperly elected one of the 3 subspecies and failed to provide a listing of claims readable on the election. Applicant was give a one month, extendable period to respond.

On March 1, 2002, the instant petition was filed. The petition argues a number of issues in separate portions of the petition. In answering these arguments, the issues have been grouped together into common issues and answered as such.

1. Applicant argues that the requirement is improper since the original drawings, specification and claims of the parent application 07/371,937, upon which applicant claims domestic priority, already gone through a restriction by a different examiner. (Applicants paragraph 5) The requirement is not proper in light of MPEP 808 because of the previous examiners restriction. (paragraph 8).

MPEP 819 states: "... *Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant.*"

In the instant case, the application is not a CPA or FWC and therefore the restriction requirement in the previous application does not carry to this application. In any event, a review of the claims of the prior application and those of the instant application are in fact different. By way of example, the prior application as originally filed did not recite a first material electrochemically loaded with a second material, or the specific materials recited in the claims of the instant application. Thus, the specific claimed invention in the parent case is different than the specific claimed invention in the second case and therefore could not be subject to the same restriction/election requirement of the prior case.

2. Applicant argues that the requirement is improper because the examiner has not explained why the various species can support separate patents, which are independent. (Applicants paragraph 5). Applicant alleges that the Examiner is coercing the applicant into double patenting (paragraph 7)

There is no requirement that requires the examiner to explain why the various species can support separate patents. The examiner is, however, required to make an initial determination as to whether the species are patentably distinct from one another. If the applicant does not agree that the inventions are independent or distinct, he may submit reasons why or merely state on the record that they are not patentably distinct when the election is made. At that time, the requirement will be withdrawn.

3. Applicant argues that the requirement is improper since it is "...inappropriate to dissect the claims into old and new elements and then to ignore the presence of old elements in the analysis." *Diamond V. Diehr*, 209 USPQ 1 (1981).

This statement in *Diamond v. Diehr* was with respect to claims being eligible for patent protection under 35 U.S.C. 101. The examiner has not made any rejection under section 101 thus rendering this argument inapplicable to the instant set of facts.

4. Applicant argues that the examiner has “taken” all of applicant’s inventions in what appears to be retaliation and an appearance of unfairness by the Office.

The office typically assigns all related applications to a single examiner for consistency and efficiency. In this unit, the examiner does not make decisions on which cases are assigned to him, as those are the functions of the supervisory primary examiner. Thus, the examiner did not “take” all applicants cases, but rather they were assigned to the examiner. The applicant’s allegation with respect to “retaliation” by the examiner is unfounded since the examiner has never previously examined any of the applicant’s prior applications. Applicant is reminded about conducting business with the U.S. Patent and Trademark Office outlined in 37 CFR 1.3, as stated below, any further comments with respect to complaints against the examiner not provided in correspondence separate from any patent application will be returned to the applicant:

§ 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner’s direct order. Complaints against examiners and other employees must be made in correspondence separate from other papers.

5. The applicant argues that the examiner ignores his requests for constructive assistance pursuant to MPEP 707.07(j).

This section of the MPEP indicates that the examiner should provide assistance in drafting an allowable claim when it becomes apparent that the application contains allowable subject matter. However in this application, prosecution on the merits has not yet begun and therefore it is apparent that it is premature for the examiner to identify any allowable subject matter.

6. The examiner refuses to personally sign his documents.

A review of the file reveals that the examiner has personally signed the requirement for election of species as well as the notice of non-compliant amendment. Applicant is in receipt of a copy of the Office action. Applicant is directed to MPEP 707.09 wherein it states that only the original copy is signed by the examiner.

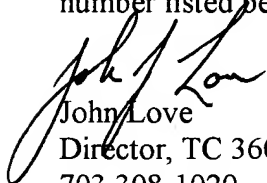
7. Recluse the examiner from the applicant’s cases.

Applicant’s request is being denied as applicant’s comments are mere allegations not based on any actions with respect to this application. However, it is being noted that the applications has been transferred to a new examiner as part of a docket realignment within the Art Unit.

In light of the above, the actions of the examiner in this application are within the proper procedures and guidelines of the Office. Applicant's request to correct the Office actions mailed on May 07, 2001 and January 16, 2002 are DENIED.

The application is being returned to the file storage area awaiting applicant's response to the Office action mailed on January 16, 2002.

Any question regarding this decision should be directed to Michael J. Carone at the number listed below.


John Love
Director, TC 3600
703 308-1020